

Union Calendar No. 245

108TH CONGRESS
2D SESSION

H. R. 2391

[Report No. 108–425]

To amend title 35, United States Code, to promote research among universities, the public sector, and private enterprise.

IN THE HOUSE OF REPRESENTATIVES

JUNE 9, 2003

Mr. SMITH of Texas (for himself, Mr. BERMAN, Mr. CONYERS, Mr. COBLE, Mr. GOODLATTE, Mr. GREEN of Wisconsin, Ms. HART, Mr. BOUCHER, Ms. LOFGREN, Mr. WEXLER, and Ms. BALDWIN) introduced the following bill; which was referred to the Committee on the Judiciary

FEBRUARY 24, 2004

Additional sponsors: Mr. FORBES, Mr. KIND, and Mr. HYDE

FEBRUARY 24, 2004

Reported with amendments, committed to the Committee of the Whole House on the State of the Union, and ordered to be printed

[Strike out all after the enacting clause and insert the part printed in italic]

[For text of introduced bill, see copy of bill as introduced on June 9, 2003]

A BILL

To amend title 35, United States Code, to promote research among universities, the public sector, and private enterprise.

1 *Be it enacted by the Senate and House of Representa-*
2 *tives of the United States of America in Congress assembled,*

1 **SECTION 1. SHORT TITLE.**

2 *This Act may be cited as the “Cooperative Research*
 3 *and Technology Enhancement (CREATE) Act of 2004”.*

4 **SEC. 2. COLLABORATIVE EFFORTS ON CLAIMED INVEN-**
 5 **TIONS.**

6 *Section 103(c) of title 35, United States Code, is*
 7 *amended to read as follows:*

8 “(c)(1) *Subject matter developed by another person,*
 9 *which qualifies as prior art only under one or more of sub-*
 10 *sections (e), (f), and (g) of section 102 of this title, shall*
 11 *not preclude patentability under this section where the sub-*
 12 *ject matter and the claimed invention were, at the time the*
 13 *claimed invention was made, owned by the same person or*
 14 *subject to an obligation of assignment to the same person.*

15 “(2) *For purposes of this subsection, subject matter de-*
 16 *veloped by another person and a claimed invention shall*
 17 *be deemed to have been owned by the same person or subject*
 18 *to an obligation of assignment to the same person if—*

19 “(A) *the claimed invention was made by or on*
 20 *behalf of parties to a joint research agreement that*
 21 *was in effect on or before the date the claimed inven-*
 22 *tion was made;*

23 “(B) *the claimed invention was made as a result*
 24 *of activities undertaken within the scope of the joint*
 25 *research agreement; and*

1 “(C) the application for patent for the claimed
 2 invention discloses or is amended to disclose the
 3 names of the parties to the joint research agreement.

4 “(3) For purposes of paragraph (2), the term ‘joint
 5 research agreement’ means a written contract, grant, or co-
 6 operative agreement entered into by two or more persons
 7 or entities for the performance of experimental, develop-
 8 mental, or research work in the field of the claimed inven-
 9 tion.”.

10 **SEC. 3. EFFECTIVE DATE.**

11 (a) *IN GENERAL.*—The amendments made by this Act
 12 shall apply to any patent granted on or after the date of
 13 the enactment of this Act.

14 (b) *SPECIAL RULE.*—The amendments made by this
 15 Act shall not affect any final decision of a court or the
 16 United States Patent and Trademark Office rendered before
 17 the date of the enactment of this Act, and shall not affect
 18 the right of any party in any action pending before the
 19 United States Patent and Trademark Office or a court on
 20 the date of the enactment of this Act to have that party’s
 21 rights determined on the basis of the provisions of title 35,
 22 United States Code, in effect on the day before the date of
 23 the enactment of this Act.

Amend the title so as to read: “A bill to amend title
 35, United States Code, to promote cooperative research

involving universities, the public sector, and private enterprises.”.

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